



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

FAY KAPLUN & MARCIN, LLP
150 BROADWAY, SUITE 702
NEW YORK, NY 10038

COPY MAILED

MAR 25 2008

OFFICE OF PETITIONS

In re Application of	:	
Huayan Amy Wang	:	
Application No. 10/809,599	:	ON PETITION
Filed: March 25, 2004	:	
Attorney Docket No. 40146/26401(1611)	:	

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed October 5, 2007, to revive the above-identified application.

The petition is **DISMISSED**.

The application became abandoned for failure to timely reply within the meaning of 37 CFR 1.113 to the final Office action, mailed March 9, 2007, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on June 10, 2007.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. See MPEP 711.03(c)(II)(C) and (D). The instant petition lacks item(s) (1).

The reply filed concurrently with the petition to revive does not place the case in condition for allowance. A proper reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2)), an amendment that prima facie places the application in condition for allowance, a Request for Continued Examination (RCE) and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(II)(A)(2). Since the amendment submitted does not prima facie place the application in condition for allowance, the reply required must be a Notice of Appeal (and appeal fee), RCE, or the filing of a continuing application under 37 CFR 1.53(b).

There is no indication that the person signing the instant petition has power of attorney or has authorization of agent to prosecute the above-identified application. In accordance with 37 CFR 1.34(a), the signature appearing on the petition shall constitute a representation to the United States Patent and Trademark Office that he/she is authorized to represent the particular party in whose behalf he/she acts.

However, if petitioner desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. A courtesy copy of this decision is being mailed to petitioner. Nevertheless, all future correspondence regarding this application file will be directed solely to the address of record until otherwise instructed.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.


Further correspondence with respect to this matter should be addressed as follows:

By Mail: Mail Stop PETITION
 Commissioner for Patents
 P. O. Box 1450
 Alexandria, VA 22313-1450

By hand: U. S. Patent and Trademark Office
 Customer Service Window, Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

The centralized facsimile number is **(571) 273-8300**.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-1642.


April M. Wise
Petitions Examiner
Office of Petitions

Attachment: Advisory Action

cc: ROBERT MAIER
 BAKER BOTTS, LLP
 30 ROCKEFELLER PLAZA
 44TH FLOOR
 NEW YORK, NY 10112

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/809,599

Applicant(s)

WANG, HUAYAN AMY

Examiner

Zachary A. Davis

Art Unit

2137

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 October 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☒ Other: See Continuation Sheet.


EMMANUEL L. NOISE
SUPERVISORY PATENT EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments are not persuasive.

In reference to the objection to the specification and the rejection of Claims 3-9, 12-17, and 21-35 under 35 U.S.C. 112, second paragraph, Applicant asserts that it is obvious that the version of the standard incorporated by reference into the application would be the version of the standard that was current as of the filing date (pages 2-3 of the present response). However, the Examiner notes that this version of the standard that was current as of the filing date (pages 2-3 of the present response) was not explicitly clear from the specification (again, see page 5, paragraph 0016, of the present specification, where no date or version is recited), and earlier versions may have been relied upon between original drafting of the application and filing of the application. Applicant also asserts that the citation of or reference to IEEE standards "is a common practice before the USPTO" (page 3 of the present response). In response, the Examiner first notes that, because the facts have not been contested, Applicant appears to have conceded that the IEEE Standards 802.11a, 802.11b, and 802.11g are evolving standards and also that they are trademarks of the IEEE. The Examiner further notes that the fact that the terms appear in other patents, for example, the five patents cited by Applicant, does not have any bearing on the facts of the present application; it is noted that the specifications of those patents may have been enabling for a specific version or date of the specifications, or the prosecution history of those applications as a whole otherwise makes clear the version or dates of the specifications, such that they are rendered definite within the context of the application as a whole. Further, the fact that the terms may appear in other patent specifications or claims does not overcome the rejections as applied in the present application since no clear evidence has been presented in support of the definiteness of the claimed subject matter. Additionally, although Applicant notes that the Macaulay reference, US 2003/0135762, also refers to IEEE 802.11 throughout the specification and claims, the Examiner notes that this document is only a patent application publication and not an issued patent, and it is possible that the use of those terms may have raised objections or rejections in the context of the prosecution of that application, and is therefore entirely moot.

In reference to the objection to the previous amendment under 35 U.S.C. 132(a) as introducing new matter, Applicant argues that "rephrasing" the references to IEEE Standard 802.11 to narrow the references to refer only to amendments a, b, and g does not constitute the addition of new matter, citing MPEP § 2163.07. However, the Examiner notes that section I. of MPEP § 2163.07 states that "a rewording of a passage where the same meaning remains intact is permissible", and in this case, the meaning has not remained intact, but rather is changed by narrowing the definition to encompass only a portion of the specification that was originally recited. Therefore, the narrowing of the definition changes the scope of the disclosure and constitutes new matter, as detailed in the previous Office action.

Regarding the rejection of Claims 1-17 and 19-35 under 35 U.S.C. 103(a) as unpatentable over Macaulay, US 2003/0135762, in view of Hrastar, US 7042852, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Specifically, Applicant argues that the cited portions of Hrastar fail to disclose comparing format of received data packets to a protocol-specified format, for example (see page 4 of the present response). However, Macaulay was relied on to show these features (see page 6 of the previous Office action). The Examiner believes that the combination of Macaulay and Hrastar therefore at least suggests maintaining a state table and comparing the format and state information of received packets to a protocol-specified format and state information in the state table, for the reasons previously cited. Further, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., looking at a WEP flag or protocol version field, see page 5 of the present response) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Continuation of 13. Other: The Examiner notes that although the present response states that a request for continued examination was filed concurrently with the present response, it does not appear that an RCE was, in fact, received in the present application, nor was there a fee paid for the filing of an RCE.